IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	: Catherine Tornabene et al.	Art Unit	: 2143
Serial No.	: 09/810,625	Examiner	: Jerry B. Dennison
Filed	: March 19, 2001		
Title	: SHARED GROUPS ROSTERING SYSTEM		

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

BRIEF ON APPEAL

(1) Real Party in Interest

America Online, Inc. is the real party in interest.

(2) Related Appeals and Interferences

There are no related appeals or interferences.

(3) Status of Claims

Claims 1-55 are pending, with claims 1, 24, 34, and 35 being independent.

(4) Status of Amendments

All amendments have been entered.

(5) Summary of Claimed Subject Matter

Independent claim 1 is directed to a method of sharing information among members of a group. The method is implemented in a computer system. See, e.g., Application, Page 17, Line 2 to Page 18, Line 7; Figs. 1-6. The computer system stores information about more than one current member of a group in a database. See, e.g., Application, Page 16, Line 15 to Page 17, Line 2; Fig. 5, Element 5914; Fig. 6, Element 6374. The computer system receives instructions from at least one current member to invite at least one prospective member to join the group. See, e.g., Application, Page 18, Line 18 to Page 19, line 9; Page 21, Lines 15 to Page 22 Line13;

Figs. 6, Element 6350; Fig. 7, Elements 710, 720. The computer system sends an invitation to the prospective member to join the group. See, e.g., Application, Page 18, Line 18 to Page 19, line 9; Page 21, Lines 15-31; Figs. 6, Element 6350; Fig. 7, Elements 705, 715. The computer system receives a response from the prospective member. See, e.g., Application, Page 18, Line 18 to Page 19, line 9; Page 22, Lines 1-23; Figs. 6, Element 6350; Fig. 7, Elements 725, 730. The computer system adds the prospective member to the group as a new member based upon receipt of an affirmative response; See, e.g., Application, Page 18, Line 18 to Page 19, line 9; Page 22, Lines 14-23; Figs. 6, Element 6350; Fig. 7, Elements 740. The computer system automatically updates services to current members to account for the new member. See, e.g., Application, Page 18, Line 18 to Page 19, line 9; Page 22, Line 20 to Page 23 Line 2; Figs. 6, Element 6350; Fig. 7, Elements 745.

Independent claim 24 is directed to a system for sharing information among members of a group. See, e.g., Application, Page 20, Line 12 to Page 21, line 14; Figs. 6, Element 600. A group administrator processes information about the current members of the group. See, e.g., Application, Page 19, Lines 9-19; Figs. 6, Element 6370. A group communicator cooperates with the group administrator for delivering and exchanging information with current and prospective group members. See, e.g., Application, Page 18, Line 18 to Page 19, line 8; Figs. 6, Element 6350. A group information updater cooperates with the group communicator and group administrator for providing automatically updated services to current members including a new member. In response to an affirmative response to an invitation to a prospective member to join the group, the group information updater is instructed by the group communicator to add the prospective member to the group. See, e.g., Application, Page 19, Lines 20-24; Figs. 6, Element 6380.

Independent claim 34 is directed to a graphical user interface for inviting a prospective member of a group to join the group. See, e.g., Application, Page 25, Lines 24-31; Figs. 8, Element 800. The graphical user interface includes an invitation for the prospective member to join the group. See, e.g., Application, Figs. 8, Element 802. The graphical user interface also includes a name of the group, a list of one or more current members of the group and a tool for the prospective member to respond to the invitation. See, e.g., Application, Page 25, Lines 25-29; Figs. 8, Elements 805, 810, 615 and 820 respectively.

Independent claim 35 is directed to a computer program, stored on a computer readable medium. The computer program includes instructions for storing information about more than one current member of a group in a database. See, e.g., Application, Page 16, Line 15 to Page 17, Line 2; Fig. 5, Element 5914; Fig. 6, Element 6374. The computer program also includes receiving instructions from at least one current member to invite at least one prospective member to join the group. See, e.g., Application, Page 18, Line 18 to Page 19, line 9; Page 21, Lines 15 to Page 22 Line13; Figs. 6, Element 6350; Fig. 7, Elements 710, 720. The computer program further includes sending an invitation to the prospective member to join the group and receiving a response from the prospective member. See, e.g., Application, Page 18, Line 18 to Page 19, line 9; Page 21, Lines 15-31; Figs. 6, Element 6350; Fig. 7, Elements 705, 715. The computer program also includes adding the prospective member to the group as a new member based upon receipt of an affirmative response. See, e.g., Application, Page 18, Line 18 to Page 19, line 9; Page 22, Lines 1-23; Figs. 6, Element 6350; Fig. 7, Elements 725, 730, 740, 745. The computer program further includes automatically updating services to current members to account for the new member. See, e.g., Application, Page 18, Line 18 to Page 19, line 9; Page 22, Line 20 to Page 23 Line 2; Figs. 6, Element 6350; Fig. 7, Elements 745.

(6)   Grounds of Rejection

Claims 1-10, 14-44, 54 and 55 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Sonnenreich (U.S. 5,974,446). Claims 11-13, which depend from independent claim 1, stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sonnenreich.

Claims 45-53, which depend from independent claim 1, stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sonnenreich in view of Simonoff (U.S. 6,351,777).

(7)   Argument

The Rejection Of Claims 1-10, 14-44, 54 and 55 As being anticipated by Sonnenreich Should Be Reversed.

Sonnenreich fails to support the presently pending rejection of claims 1-33, 35-44 and 54-55 under 35 U.S.C. §102(b) as it fails to disclose, expressly or inherently, at least one feature

recited by those claims – namely the control of group membership based on an invitation/acceptance model.

In independent claim 1, Applicant claims a process whereby membership of a group is controlled based on an invitation/acceptance model, where a group member sends an invitation to desired candidates, and those candidates become group participants upon acceptance of the invitation.

Controlling group membership based on an invitation/acceptance model is not disclosed by Sonnenreich. In fact, Sonnenreich never even refers the notion of invitation and acceptance, much less application of invitation and acceptance as a mechanism for controlling group membership.

With respect to the claimed use of invitation and acceptance to control group membership, the office action cites to a portion of Sonnenreich that clearly fails to address either of an invitation or an acceptance. Specifically, the office action cites to Col. 3, lines 54-56 and Col. 4, lines 25-45, a portion of Sonnenreich that merely suggests the notion of a private group. Without any further support, the office action states that Sonnenreich's reference to a private group meets the claimed invitation/acceptance steps. This position is simply not tenable.

Mere disclosure of a "private" group does not suggest the mechanism used to control membership within such a private group. To the contrary, at least one mechanism that does not rely upon invitations or acceptances is commonly used to establish membership within a private group. By way of example, a user wishing to establish a private group could simply select identities corresponding to other users that they wish to include in their private group, and their selection alone may suffice to establish and control membership without any subsequent or corresponding invitation or acceptance being provided to the other selected co-participants.

Additionally, the notion of a "private" group in Sonnenreich's context appears to suggest that the group membership is only known to its owner, as in contrast to a normal group, where the other group members are aware of the group membership. Hence, the "private" group of Sonnenreich's precludes the group members, other than the owner, to have knowledge of such a group. This result is the opposite of Applicant's invitation/acceptance model created group, where prospective members are notified and confirmed as a condition precedent to their membership on the group.

To be clear, through its disclosure of a private group, Sonnenreich makes no disclosure of invitation/acceptance. And, given the existence of alternative mechanisms for controlling private group participation/membership, such as those discussed above which do not include the need for an invitation/acceptance, the claimed use of invitation and acceptance as a mechanism for controlling group membership/participation cannot be said to be inherent in Sonnenreich's mere mention of private groups.

For at least these reasons, it is clear that Sonnenreich fails to meet the rigorous burden of teaching imposed under 35 U.S.C. §102(b), such that Applicants respectfully request reconsideration and withdrawal of the rejection of independent claims 1, 24 and 35 and their respective dependent claims, namely claims 2-33, 36-44, and 54-55.

Further, claim 34 recites a graphical user interface for inviting a prospective member of a group to join the group, which is not disclosed by Sonnenreich. For reasons described above, the limitations of claim 34 (including the inviting aspect) are not taught by Sonnenreich and the rejection of claim 34 under 35 U.S.C. §102(b) should be withdrawn.

The Rejection Of Claims 11-13 As being obvious by Sonnenreich in view of Simonoff Should Be Reversed.

The combination of Sonnenreich and Simonoff also fails to disclose the missing feature, and thus fails to support the presently pending rejection of claims 45-53 under 35 U.S.C. §103.

With respect to claims 45-53, Applicants respectfully request reconsideration and withdrawal of their rejection under 35 U.S.C. §103 because Sonnenreich and Simonoff, either alone or in combination, fail to describe or suggest the features discussed above with respect to independent claim 1 upon which claims 45-53 depend. In fact, Applicants note that Sonnenreich's failure to mention invitation/acceptance as a mechanism for inclusion within a group is amplified by Sonnenreich's teaching of an alternative manner for enabling entities to participate in its groups. Specifically, Sonnenreich clearly indicates that user's attributes may be used identify users to be included in a group. Sonnenreich goes so far as providing an example of its alternative to invitation/acceptance, i.e., creating groups based on common topics of interests chosen by the user. See, e.g., Sonnenreich, Col. 8, lines 20-38. In the absence of any disclosures by either Sonnenreich or Simonoff of invitation or acceptance, disclosure by
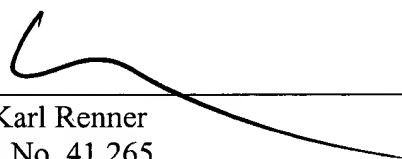
Sonnenreich of this alternative process for establishing group membership would lead those relying upon Sonnenreich away from use of invitation or acceptance, absent the impermissible hindsight gleaned from the present application.

For at least these reasons, Applicants respectfully request withdrawal of the § 103(a) rejection of claims 45-53.

A check in the amount of $950 is enclosed of which $500 is for the brief fee and $450 is for a two-month extension of time fee. Please apply any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: 12/27/2005

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Appendix of Claims

1. (Rejected): A computer implemented method of sharing information among members of a group, the method comprising:

storing information about more than one current member of a group in a database;

receiving instructions from at least one current member to invite at least one prospective member to join the group;

sending an invitation to the prospective member to join the group;

receiving a response from the prospective member;

adding the prospective member to the group as a new member based upon receipt of an affirmative response; and

automatically updating services to current members to account for the new member.

2. (Rejected): The computer implemented method of claim 1 wherein sending the invitation comprising using an e-mail message.

3. (Rejected): The computer implemented method of claim 1 wherein sending the invitation comprises using an instant message.

4. (Rejected): The computer implemented method of claim 1 wherein sending the invitation comprises using an on-line chat room.

5. (Rejected): The computer implemented method of claim 1 wherein receiving the response comprises receiving the response as an e-mail message.

6. (Rejected): The computer implemented method of claim 1 wherein receiving the response comprises receiving the response as an instant message.

7. (Rejected): The computer implemented method of claim 1 wherein receiving the response comprises receiving the response in an on-line chat room.

8. (Rejected): The computer implemented method of claim 1, wherein automatically updating services comprises providing a list of current members that includes the new member.

9. (Rejected): The computer implemented method of claim 1 wherein automatically updating services comprises providing information in an address book that includes address information for the new member.

10. (Rejected): The computer implemented method of claim 9 further comprising updating the address book based upon information entered by the current members of the group.

11. (Rejected): The computer implemented method of claim 1 wherein automatically updating services comprises providing information in a calendar that includes information for the new member.

12. (Rejected): The computer implemented method of claim 11 further comprising updating the calendar based upon information entered by the current members of the group.

13. (Rejected): The computer implemented method of claim 11 further comprising inviting current group members to attend an event and automatically recording the event in the calendar.

14. (Rejected): The computer implemented method of claim 1 wherein automatically updating services comprises providing an on-line forum for current members of the group to chat with other current members of the group including the new member.

15. (Rejected): The computer implemented method of claim 1 wherein automatically updating services comprises enabling current members of the group to send instant messages to other current members of the group including the new member.

16. (Rejected): The computer implemented method of claim 1 wherein automatically updating services comprises enabling current members of the group to share data files with other current members of the group including the new member.

17. (Rejected): The computer implemented method of claim 16 wherein the data files are provided by the current members of the group.

18. (Rejected): The computer implemented method of claim 16 wherein data files comprise digital images.

19. (Rejected): The computer implemented method of claim 16 wherein data files comprise photographs.

20. (Rejected): The computer implemented method of claim 16 wherein data files comprise text files.

21. (Rejected): The computer implemented method of claim 16 wherein data files comprise multi-media files.

22. (Rejected). The computer implemented method of claim 1 further comprising offering new services based upon the current members of the group including the new member.

23. (Rejected): The computer implemented method of claim 1 wherein automatically updating services comprises providing information in an instant messaging buddy list that includes information for the new member.

24. (Rejected): A communication system for sharing information among members of a group comprising:

a group administrator for processing information about the current members of the group;

a group communicator cooperating with the group administrator for delivering and exchanging information with current and prospective group members; and

a group information updater cooperating with the group communicator and group administrator for providing automatically updated services to current members including a new member, wherein in response to an affirmative response to an invitation to a prospective member to join the group, the group information updater is instructed by the group communicator to add the prospective member to the group.

25. (Rejected): The communication system of claim 24 wherein the group administrator further comprises:

a group member profile server for updating data related to current members including the new member; and

a database connected to the group member profile server for storing data related to current members including the new member.

26. (Rejected): The communication system of claim 24 wherein the group communicator further comprises:

an instant message host in communication with a client system; and

a login server in communication with a client system and the instant message host for determining whether the client is authorized to access the instant message host.

27. (Rejected): The communication system of claim 26 wherein the instant message host further comprises:

an instant message server for sending and receiving data; and

a domain server cooperating with the instant message server for providing supporting functions of the instant message host.

28. (Rejected): The communication system of claim 27 wherein the instant message host further comprises a routing gateway connected to the instant message server.

29. (Rejected): The communication system of claim 24 wherein the group communicator further comprises:

an Online Service Provider host in communication with a client system; and

a login server in communication with the client system and the Online Service Provider host for determining whether the client is authorized to access the Online Service Provider host.

30. (Rejected): The communication system of claim 26 wherein the Online Service Provider host further comprises an Online Service Provider server for sending and receiving data.

31. (Rejected): The communications system of claim 24 wherein the group information updater further comprises a user interface for communicating and exchanging data with one or more members of the group including the new member.

32. (Rejected): The communications system of claim 31 wherein the user interface resides on an Online Service Provider host.

33. (Rejected): The communications system of claim 31 wherein the user interface resides on the Internet.

34. (Rejected): A graphical user interface for inviting a prospective member of a group to join the group, the graphical user interface comprising:

an invitation for the prospective member to join the group;

a name of the group;

a list of one or more current members of the group;

and a tool for the prospective member to respond to the invitation.

35. (Rejected): A computer program, stored on a computer readable medium, comprising instructions for:

storing information about more than one current member of a group in a database;

receiving instructions from at least one current member to invite at least one prospective member to join the group;

sending an invitation to the prospective member to join the group;

receiving a response from the prospective member;

adding the prospective member to the group as a new member based upon receipt of an affirmative response; and

automatically updating services to current members to account for the new member.

36. (Rejected): The computer program of claim 35 wherein the computer readable medium is a disc.

37. (Rejected): The computer program of claim 35 wherein the computer readable medium is a client device.

38. (Rejected): The computer program of claim 35 wherein the computer readable medium is a host device.

39. (Rejected): The computer program of claim 35 wherein the computer readable medium is a propagated signal.

40. (Rejected): The method of claim 1 in which the current members of the group comprise members of a family.

41. (Rejected): The method of claim 1 in which the prospective member comprises a relative of a current member of the group.

42. (Rejected): The method of claim 1 in which storing information about all members of a group comprises storing information about all members of a private group.

43. (Rejected): The method of claim 1 in which storing information about all members of a group comprises storing information about all members of a public group.

44. (Rejected): The method of claim 1 wherein the invitation comprises a personalized message to the prospective member.

45. (Rejected): The method of claim 1 further comprising authorizing an invitation to be sent to the prospective member.

46. (Rejected): The method of claim 45 in which the authorizing is performed by a group founder.

47. (Rejected): The method of claim 45 in which the authorizing is performed by a group owner.

48. (Rejected): The method of claim 1 further comprising deleting a current member.

49. (Rejected): The method of claim 48 in which the deleting is performed by a group founder.

50. (Rejected): The method of claim 48 in which the deleting is performed by a group owner.

51. (Rejected): The method of claim 1 further comprising promoting a current member to a group owner.

52. (Rejected): The method of claim 1 further comprising denoting a group owner to a current member.

53. (Rejected): The method of claim 1 further comprising promoting a group owner to a founder.

54. (Rejected): The method of claim 1 further comprising providing a notification of the response to one or more current members.

55. (Rejected): The method of claim 1 further comprising treating the new member as a current member.

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Evidence Appendix

None

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Related Proceedings Appendix

None